



17 APR 2007

David G. Conlin  
Edwards, Angell, Palmer & Dodge, LLP  
P.O. Box 55874  
Boston, MA 02205

In re Application of	:	
FUKATSU, et al.	:	
U.S. Application No.: 10/534,081	:	DECISION ON PETITION
PCT No.: PCT/JP03/14139	:	
Int. Filing Date: 06 November 2003	:	UNDER 37 CFR 1.181
Priority Date: 08 November 2002	:	
Attorney Docket No.: 66530 (46590)	:	
For: RECEPTOR FUNCTION REGULATOR	:	

This decision is in response to applicant's petition under 37 CFR 1.181 to withdraw the holding of abandonment filed 10 October 2006 in the United States Patent and Trademark Office (USPTO).

### BACKGROUND

On 06 November 2003, applicant filed international application PCT/JP03/14139, which claimed priority of an earlier application filed 08 November 2002. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 21 May 2004. The deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 08 May 2005.

On 06 May 2005, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by payment of the full, U.S. basic national fee; an English translation of the international application as filed; an assignment document and a computer-readable form of the sequence listing.

On 13 June 2005, applicant filed a declaration of the inventors.

On 22 December 2005, applicant was mailed a NOTIFICATION TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE AND/OR AMINO ACID SEQUENCE DISCLOSURES (Form PCT/DO/EO/922) informing applicant that a copy of the "Sequence Listing" in computer readable form which complied with 37 CFR 1.821-1.825 was required. Applicant was afforded two months to file a proper response.

On 25 September 2006, applicant was mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) informing applicant that applicant had failed to respond to the Form PCT/DO/EO/922 mailed 22 December 2005 within the time period set therein and that above-

identified application was abandoned as to the United States.

On 10 October 2006, applicant filed the present petition under 37 CFR 1.181 stating that a reply was faxed to the USPTO on 11 January 2006.

### **DISCUSSION**

37 CFR 1.8(b) states:

In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding is dismissed, terminated, or decided with prejudice the correspondence will be considered timely filed if the party who forwarded the correspondence:

- (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
- (2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and
- (3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

MPEP 711.03(c) details that as stated in 37 CFR 1.8(b)(3) the statement that attests to the previous timely mailing or transmission of the correspondence must be on a personal knowledge basis, or to the satisfaction of the Director of the USPTO. If the statement attesting to the previous timely mailing is not made by the person who signed the Certificate of Mailing (i.e., there is no personal knowledge basis), then the statement attesting to the previous timely mailing should include evidence that supports the conclusion that the correspondence was actually mailed (e.g., copies of a mailing log establishing that correspondence was mailed for that application). When the correspondence is shown to have been timely filed based on a certificate of mailing, the correspondence is entered into PALM with the actual date of receipt (i.e., the date that the duplicate copy of the papers was filed with the statement under 37 CFR 1.8).

While applicant has not provided a statement with firsthand knowledge of the fax

transmission, applicant has included a copy of the auto-reply facsimile transmission from the USPTO and counsel has attested that the presently filed materials are true copies of the papers originally faxed to the Office on 11 January 2006. Thus, applicant has satisfied items all three items above and it is proper to GRANT applicant's petition under 37 CFR 1.181 to withdraw the holding of abandonment.

**CONCLUSION**

For the reasons detailed above, applicant's petition under 37 CFR 1.181 is GRANTED.

The Form PCT/DO/EO/909 mailed 25 September 2006 is hereby VACATED.

This application is being returned to the United States National Stage processing division (US/DO/EO) for consideration of applicant's response including whether the response, while considered timely, was a proper response to the Form PCT/DO/EO/922 mailed 22 December 2005.



Derek A. Putonen  
Attorney Advisor  
Office of PCT Legal Administration  
Tel: (571) 272-3294  
Fax: (571) 273-0459